

REMARKS

In the Office Action dated September 9, 2003, the Examiner rejected claims 1-3, 5, 6, 21, 24, and 25 under 35 U.S.C §103(a) as being unpatentable over DeLorme et al. in view of Goldstein et al. Applicant has amended claim 1, the base independent claim for claims 2-8, to include the patentable feature of the computer system being capable of validating the ticket. None of the cited prior art teaches or suggests that the computer system that generated the ticket has the capability of validating the ticket.

Further, Applicant submits that there is no reason to combine these cited references in the manner suggested by the Examiner. In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP Section 2143 – Section 2143.03 for decisions pertinent to each of these criteria. In this case, none of these criteria have been met.

In rejecting claims under 35 U.S.C. §103, it is incumbent upon the Examiner to provide a reason why one having ordinary skill in the art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion, or inference in the prior art as a whole

or knowledge generally available to one having ordinary skill in the art. *Uniroyal, Inc. v. Rudkin-Wiley*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984); *In re Sernaker*, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983).

It is imperative for the decision maker to place himself back in time to when the invention was unknown, i.e., without the applicant's disclosure at his side, and determine, in light of all the objective evidence bearing on the issue of obviousness, whether one having ordinary skill in the art would have found the claimed invention as a whole under 35 U.S.C. §103. *Panduit v. Dennison Mfg. Co.*, 774 F.2d 1082, 227 USPQ 337 (Fed. Cir. 1985), *vacated* 475 U.S. 809, 229 USPQ 478 (1986), *aff'd on remand*, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987).

In rejecting all of the claims pending herein, the Examiner has apparently pieced together two or more prior art references, based upon having Applicant's disclosure before him, in concluding that it would have been obvious to combine the references. As the courts have frequently warned the use of "hindsight" in determining obviousness is improper. *In re Manurkar Patent Litigation*, 28 USPQ2d 1801 (N.D. Ill. 1993), is a case in which Judge Easterbrook stated that "decomposing an invention into its constituent elements, finding each element in the prior art, and then claiming that it is easy to reassemble these elements into the invention, is a forbidden ex post analysis."

Further, Judge Easterbrook stated *Id.* at 1817: With hindsight the transistor is obvious; but devising the transistor was still a work of genius. An invention lies in a combination of elements that are themselves mundane. ... Unless the prior art itself

suggest the particular combination, it does not show that the actual invention was obvious or anticipated.

It is impermissible to use the inventor's disclosure as a "road map" for selecting and combining prior art disclosures. *Grain Processing Corp. v. American Maize-Products Corp.*, 5 USPQ2d 1788, 1792, (Fed. Cir. 1988); *American Medical Systems Inc. v. Medical Engineering Corp.*, 26 USPQ2d 1081, 1091 (E.D. Wis. 1992), *aff'd in part, rev'd in part & remanded*, 28 USPQ2d 1321 (Fed. Cir. 1993).

It is only with the Applicant's disclosure that the Examiner can conclude that it would have been obvious to combine DeLorme et al. with Goldstein et al. The DeLorme et al. reference discloses a travel reservation and information planning system. There is no reason to combine the system disclosed in DeLorme et al. with that disclosed in Goldstein et al. There is simply no reason or suggestion provided within the references themselves to combine the references in the manner suggested by the Examiner. Absent some teaching, suggestion, or inference in the prior art, the §103 rejection is improper.

With respect to the rejection of claim 21, claim 21 includes the patentable feature of the validation system being connected to the computer system that provided the ticket signal with the computer system being capable of validating the ticket signal to determine if entrance to the event should be allowed. The Examiner has misread the claim language in making the §103 rejection and has not addressed this particular feature. Further, there is no teaching or suggestion in the cited references themselves to combine the references in the manner suggested by the Examiner.

Regarding the rejection of claims 24 and 25, such claims depend from claim 21 that has been shown to be allowable. In view of this, claims 24 and 25 are allowable for the same reasons.

With respect to the rejections of claims 4, 7, and 8, such claims depend from claim 1, the base independent claim, that above has been shown to be allowable. It is urged that claims 4, 7, and 8 are allowable for the same reasons.

Applicant requests reconsideration of the rejection of claim 9 under 35 U.S.C §103(a) as being unpatentable over DeLorme et al. and Goldstein et al. and further in view of a web page timeline of press releases distributed by TeamCard. Applicant has amended claim 9, the base independent claim for claims 10-17, to include the patentable feature of the computer system being capable of validating the ticket. None of the cited prior art teaches or suggests that the computer system that generated the ticket has the capability of validating the ticket. Further, it is only with the Applicant's disclosure that the Examiner can conclude that it would have been obvious to combine DeLorme et al., Goldstein et al, and the TeamCard reference. There is simply no reason or suggestion provided within the references themselves to combine the references in the manner suggested by the Examiner. Absent some teaching, suggestion, or inference in the prior art, the §103 rejection is improper and should be withdrawn. Claims 10-17 that depend from claim 9 are allowable for the same reasons.

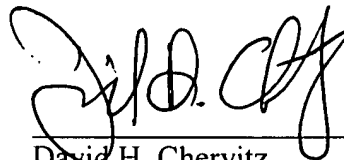
Applicant respectfully requests reconsideration of the rejection of claims 18, 19, and 20. Claim 18 includes the patentable feature of the validating step comprising sending a validation signal to a computer system that issued the ticket with the computer system for determining if the validation signal is valid. Again, none of the cited prior art,

alone or in combination discloses this step. Also, there is simply no reason or suggestion provided within the references themselves to combine the references in the manner suggested by the Examiner. The rejection of claims 18-20 under §103 should be withdrawn.

Applicant respectfully requests reconsideration of the rejection of claims 22 and 23. Claims 22 and 23 depend from claim 21 that was shown to be allowable. Claims 22 and 23 are allowable for the same reasons and it is believed that the §103 rejection may now be withdrawn.

Applicant submits that upon entry of the amendment to the claims and consideration of the above remarks this application should be in condition for allowance. In the event that this application is for any reason not considered by the Examiner to be in form for allowance, Applicant's counsel requests the Examiner to telephone the undersigned before issuing a further action to discuss any objections the Examiner might have, thereby simplifying and expediting the examination and prosecution process.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'David H. Chervitz', is written over a horizontal line.

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